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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,684	07/11/2001	Keiichi Iwamura	862.C2291	8964

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EXAMINER

ALOMARI, FIRAS B

ART UNIT	PAPER NUMBER
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2136

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/901,684

Applicant(s)

IWAMURA, KEIICHI

Examiner

Firas Alomari

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Amendment filed on 13 June 2005 have been accepted.
2. Applicant's arguments filed 04/04/2005 have been fully considered but they are not persuasive.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Zhao US (6,754,822).

As per claim 1: Zhao discloses an inspection method for inspecting information stored in terminals that are included in a network, comprising the step of:

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- Using a program module, which moves between the terminals and **determines by using a public key digital watermarking method**, whether a digital watermark is embedded in the information. (*Col 14, Lines 1-7 & Col 18, lines 32-50*)

As per claim 2: Zhao discloses the method according to claim 1, wherein when the program module determines that a digital watermark is embedded in the information, the information is downloaded from the terminal to an inspection server. (*Col 14, Lines 21-23*)

As per claim 3: Zhao discloses the method according to claim 1, wherein when the program module determines that the digital watermark is embedded in the information, the program module then checks, based on the digital watermark, if the user of the terminal is an authentic user of the information. (*Col 15, Lines 48-54*)

As per claim 4: Zhao discloses an inspection system comprising an inspection host for moving a program module, **determines by using a public key digital watermarking method whether** a digital watermark is embedded in information stored in a terminal, between terminals that are included in a network. (*Col 14, Lines 16-23 & Col 18, lines 32-50*)

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As per claim 5: Zhao discloses a recording medium that stores a program module which moves between terminals that are included in a network and **determines by using a public key digital watermarking method whether** a digital watermark is embedded in information stored in the terminal. (Col 14, Lines 16-23 & *Col 18, lines 32-50*)

As per claim 6: Zhao discloses an inspection method comprising:

- step of disclosing a **part of digital watermark information related to a digital watermark extraction method** on a network; (Col 12, Lines 45-53)
- step of **installing at least a part of digital watermark information** in a terminal which desires the installation of the digital watermark extraction method; (Col 12, lines 53-58)
- inspection step of inspecting authenticity of information in the terminal using the digital watermark information installed in the terminal. (Col 13, Lines 13-19)

As per claims 7: Zhao discloses the method according to claim further comprising a step of informing, information is detected in the copyright protection when illicit use of inspection step, a terminal of the detection via the network. (Col 13, Lines 40-46)

3. Claims 15 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Zhao US (6,141,753).

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As per claim 15: Zhao discloses an inspection method comprising:

Storage medium providing step of providing storage medium which stores enciphered information embedded with storage medium identification information as a digital watermark;(Col 6, lines 18-32)

A presentation request step requesting the user to present the storage medium identification and user identification information; (Col 6, lines 39-44)

A providing step of providing of providing a decipher program of the enciphered information to the user in the presence of the presentation; (Col 7, lines 11-14)

An inspection step of inspecting authenticity of information by **the user by** comparing the user identification information associated with the storage medium identification information, and user information of a terminal that stores the information (Col 10, lines 44-52/ the system use the encryption/decryption keys to track software copies and identify who using them)

As per claim 16: Zhao discloses an inspection system that sells enciphered information (Col 6, lines 55-58) which is stored in a storage medium and embedded with storage medium identification information as a digital watermark (Col 6, lines 18-32),

said system providing decipher software of the enciphered information to a user when the user presents the storage medium identification information and user identification information (Col 6, lines 39-44 and Col 7, lines 11-14),

managing the storage medium identification information and user identification information in correspondence with each other (Col 6, Lines 1-9), and

Inspecting authenticity information by **the user by** comparing the user identification information associated with the storage medium identification information embedded as the digital watermark the information, and user information of a terminal that stores the information (Col 6, lines 50-60).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8-14 rejected under 35 U.S.C. 103(a) as being unpatentable over Zhao USP (6,754,822) in view of Smith et al. USP (6,067,822).

As per claim 8: Zhao discloses an inspection method comprising:

- Step of disclosing a **part of digital watermark information related to a** digital watermark extraction technique network; (Col 12, Lines 45-53)
- Zhao doesn't explicitly disclose a step of licensing terminal which included in the network to use the digital watermark extraction method and the step of installing

the digital watermark extraction technique in another terminal via use-licensed terminal. However Olsen et al. teaches the using of a system to distribute, license, install and monitor the use of software in a network environment (Col 2, lines 18-35 and Col 9, lines 32-44). Therefore, it would be obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Zhao with the teaching of Olsen to include a licensing system to license the digital watermark extraction technique and installs it. One would be motivated to do so in order to determine the usage of individual application in an enterprise network environment, which applications are installed on a network, and which users are using them (Col 2, lines 18-35).

- Zhao discloses an inspection step of inspecting authenticity of information in the other terminal using the digital watermark extraction **method** installed the other terminal. (Col 13, Lines 13-19)

As per claims 9: Zhao discloses the method according to claim 8 further comprising a step of informing, information is detected in the copyright protection when illicit use of inspection step, a terminal of the detection via the network. (Col 13, Lines 40-46)

As per claim 10: Zhao discloses An inspection system comprising a digital watermarking technique server which disclose a **part** of digital watermarking extraction technique on a network but doesn't show the method of licensing a terminal which is included in the network to use the digital watermarking technique. However Smith et al.

teaches the using of a system to distribute and license software in a network environment (Col 2, lines 18-35). Therefore, it would be obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Zhao with the teaching of Smith to include a step to license the digital watermark extraction technique on the terminals using it. One would be motivated to do so in order to determine the usage of individual application in an enterprise network environment, which applications are installed on a network, and which users are using them (Col 2, lines 18-35).

As per claim 11: Zhao discloses an inspection method comprising: step of providing digital representation, a technique for protecting the digital representation (Col 17, line 64 through Col 18 line 5) and authenticating the digital representation (Col 18 lines 29-36) but doesn't show the method of accepting the purchase application via the network before sending the digital representation. However Smith et al. teaches the using of a digital content distribution system that accepts a purchase application for any form of digitally stored information stored on the content server (Col 6, lines 23-26), verify user billing information (Col 7, lines 16-21) and transfer the software to the user if the verification process is successful (Col 7, lines 25-28) and require the acceptance of a user agreement before proceeding Col 5, lines 22-32). Therefore it would be obvious to a person with ordinary skill in the art at the time the invention was made to modify Zhao system with the teaching of Smith to include a step to accept and verify purchase applications before sending digital representation. One would be motivated to do so in order to enable the system to securely distributing

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software, providing control over software installation and provide a secure billing and user information for the service providers while inhibiting piracy. (Col 2, Lines 18-28)

As per claim 12: Zhao discloses the method according to claim 11, wherein the presentation step includes a step of presenting a measure to be taken against the user who illicitly used the information. (Col 16 lines 50-65)

As per claim 13: Zhao discloses the method according to claim 11, wherein the presentation step includes a step of presenting to the user an extraction program which gives an explanation about digital watermark extraction method, and can inspect digital watermark embedded in the information (Col 16, lines 19- 34), and the providing step includes a step of embedding, when identification information of the user is confirmed together with the agreement, the user identification information in the information as a digital watermark, and providing that information to the user (Col 15, lines 48-54).

As per claim 14: Zhao discloses an inspection system comprising an information vendor server that downloads digital representation to a user and require the user to agree on a protection method for the content(Col 17, line 64 through Col 18, line 5) but doesn't show the step of accepting a purchase application of information from a user via a network. However Smith et al. teaches the using of a digital content distribution system that accepts a purchase application for any form of digitally stored information stored on the content server (Col 6, lines 23-26), accept user purchase application via the network

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(Col 5, lines 56-62) and transfer the software to the user upon acceptance of the license agreement (Col 5, lines 22-32) **and providing the information protected by the copyright protecting technique which makes it possible for the user to inspect authenticity of the information, when agreement is confirmed (Col 9, lines 57-66).**

Therefore it would be obvious to a person with ordinary skill in the art at the time the invention was made to modify Zhao system with the teaching of Smith to. One would be motivated to do so in order to enable the system to securely distributing software, providing control over software installation and provide a secure billing and user information for the service providers while inhibiting piracy. (Col 2, Lines 18-28)

Response to Arguments

6. Claims 1, 4-6, 8, 11, 14-16 have been amended.

Regarding applicant argument that Zhao 822' doesn't suggest the aspect of the using a public key digital watermarking method. The examiner disagrees with applicant. Zhao explicitly teaches the using of public/private key cryptography to secure the digital watermarking methods (Col 5, lines 31-52). Furthermore Zhao discloses each digital watermark agent (module) have it's own private/public key pair which the agent use to generate encrypted messages to be sent out and composing digital signatures (Col 18, lines 5-50). Claims 35 and 36 in Zhao 822' are more specific as they disclose an encryption (public) key and a decryption (private) key for each agent.

Regarding applicant argument that Zhao doesn't teach installing watermark information in a terminal desiring to extract watermark information and inspecting the authenticity of information installed. The examiner disagrees with applicant. Zhao teaches installing a watermark reader to extract watermark information and provide information for the code interpreter to perform the watermark functions and inspect the authenticity of the data in the terminal and take some protective actions if the terminal contains un-authorized data (Col 12, line 45 through Col 13, line 45 & Col 17, line 65 through Col 18, line 5). Claims 30 and 40 are more specific as they disclose installing the watermark extraction on terminal desiring to extract the information and inspecting the data on the terminal to verify that the user is authorized to use them.

Regarding applicant argument that Zhao doesn't teach inspecting the watermark information by the user. The examiner agrees with the applicant that Zhao doesn't explicitly teach the user inspecting watermark for authenticity. However the system as modified by Smith teaches the limitation in two ways first by explicitly verifying the content before the instillation or download of the content and by using a secure socket layer protocol to verify authenticity of the transactions (Col 5 line 63 through Col 6 line 65 & See claim 13). Cols 9 & 10 are more specific as they describe the assurance methods for users.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firas Alomari whose telephone number is (571) 272-7963. The examiner can normally be reached on M-F from 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, AYAZ SHEIKH can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FA

Firas Alomari
Examiner
Art Unit 2136

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8/22/05